

DETAILED ACTION

The amendment received on February 28, 2008 is acknowledged and entered..
No claims have been added. Claims 1-22 are currently pending.

Response to Amendment and Arguments

Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 10 and 12-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 10 and 12-13 are written in "single means claim" format since they recite only one element to do all the functions recited. The claim is not written in "means-plus-function" language, however, in *Fiers v. Revel*, (CAFC) 25 USPQ2d 1601, 1606 (1/19/1993), the CAFC affirmed a rejection under 35 USC 112 of a claim reciting a single element that did not literally use "means-plus-function" language. Claims 10 and 12-13 are drawn to any "data processor", regardless of construct, that performs the

function recited. This parallels the fact situation in Fiers wherein "a DNA" and a result was recited. The CAFC stated in Fiers at 1606, "Claiming all DNA's that achieve a result without defining what means will do so is not in compliance with the description requirement; it is an attempt to preempt the future before it has arrived." See also *Ex parte Maizel*, (BdPatApp&Int) 27 USPQ2d 1662, 1665 and *Ex parte Kung*, (BdPatApp&Int) 17 USPQ2d 1545, 1547 (1/30/1989) wherein the claims at issue were rejected for being analogous to single means claims even though "means" was not literally used. Thus, claims 10 and 12-13 yield a "data processor" that achieves a result without defining what will do so.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

obtaining a one-time cost factor for a single power failure; and

obtaining a cost per hour without power factor.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 5, 8, 10, 12, 14-15, 18 and 21, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fallon et al. (US PG Pub. 2003/032949), in view of "Cash flow, Energy performance, and Environmental Protection, What's the Link?

ENERGYSTAR® (hereinafter referred to as "ENERGYSTAR®").

As per Claims 1, 10, and 14, Fallon discloses a method, calculator and computer program product that estimates a cost savings attributable to use of a backup power system, comprising the following steps implemented in a data processing system: obtaining historical power status information relating to operation of the backup power system (§ [0016]-[0017];[0081];[0108]-[0109]; FIG. 10).

Fallon fails to disclose the computing the estimate of cost savings from the obtained historical power status information.

However, ENERGYSTAR® discloses ENERGY STAR's CFO calculator takes a practical look at your energy situation and you can choose either (a) best estimates of how your building currently operates and how much better it *could* operate, or (b) data generated when you use ENERGY STAR's portfolio manager.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Fallon et al. to include the feature of "ENERGYSTAR®" in order to inform the user of a cost savings realized through the use of such a device.

As per claims 2, 8, 12, 15 and 21, Fallon further discloses wherein the received historical power status information comprises at least one of a number of power failures and a duration of the power failures, wherein the power outage cost factor comprises a one-time cost factor for a single power failure and/or a cost per hour without power factor and wherein the user interface comprises a graphical user interface (GUI). (Figure 10).

As per claims 5 and 18, Fallon fails to disclose the method of claim 4 further comprising exporting the per incident savings estimate, the hourly savings estimate and/or the estimate of cost savings to a computer application. However, Eulau discloses the exporting of the estimated data to a computer application. (Figure 1; Figure 19; Col. 2, lines 10-13; Col. 3, line 40 - Col. 4, line 10). Examiner interprets exporting to include the computation of data by a computer or Internet server and the sending of that data to another computer application (i.e. web browser).

As per claims 6 and 19, Fallon further discloses the method of Claim 4 further comprising displaying the one-time cost factor, the cost per hour factor, the number of power failures, the duration of the power failures, the per incident savings estimate, the hourly savings estimate and the estimate of cost savings on a graphical user interface (GUI) (Figure 10; 0009; 0016; 0017).

4. Claims 3-4, 9, 13, 16-17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fallon et al. (US PG Pub. 2003/032949, in further view of

"ENERGYSTAR®", still in further view of Eulau et al. (US Patent Number 6,411,910),

As per claim 3 and 16, Fallon fails to disclose the method of claim 2 further comprising: obtaining a one-time cost factor for a single power failure; and obtaining a cost per hour without power factor.

However, Eulau teaches the collection and generation of various data pertaining to the costs associated with a power loss. (Figures 5-19; Col. 2, lines 5-50; Col. 3, line 65 - Col. 4, line 10; Col. 5, line 55 - Col. 6, line 15) Examiner interprets the data collected in Eulau to include both the cost per hour and single incident cost because the collection of data includes a wide range of values that can be used to accurately compute both of these values. In fact, cost per hour values are explicitly disclosed and the cost per incident value is merely a function of the cost per hour value. Further, Examiner interprets the total revenue and profit at risk generated by Eulau to be the same as the potential amount saved by a backup power supply. This is because the backup power supply eliminates power failures and reduces the risk to zero, thus recovering the total revenue and profit that was initially at risk.

Therefore, it would have been obvious to one of ordinary skill in the art to modify the invention of Fallon and Sneering to include the features of Eulau, because informing the user of a backup power supply of the cost savings realized through the use of such a device is an excellent means to justify the purchase and maintenance of a backup power supply and provide the user with additional data concerning the operation of their backup power supply.

As per claims 4, 9, 13, 17 and 22, Fallon shows the collection of data pertaining to power failure incidents and the duration of the power failures. Fallon further computes the total power failures and the total duration of power failures and displays these results to the user through a GUI. (Figure 10). Fallon fails to disclose calculating a per incident savings estimate based on the number of power failures and the one-time cost factor; calculating an hourly savings estimate based on the duration of the power failures and the cost per hour without power factor; and calculating the estimate of cost savings associated With the backup power system based on the calculated per incident savings estimate and the calculated hourly savings estimate.

However, Eulau teaches the collection and generation of various data pertaining to the costs associated with a power loss. (Figures 5-19; Col. 2, lines 5-50; Col. 3, line 65 - Col. 4, line 10; Col. 5, line 55 - Col. 6, line 15). The Examiner interprets the data collected in Eulau to include both the cost per hour and single incident cost because the collection of data includes a wide range of values that can be used to accurately compute both of these values. Further, the Examiner interprets the total revenue and profit at risk generated by Eulau to be the same as the potential amount saved by a backup power supply. This is because a backup power supply abolishes power failures and reduces the risk to zero, thus recovering the total revenue and profit that was initially at risk.

Therefore, it would have been obvious to one of ordinary skill in the art to include the features of Eulau and "ENERGYSTAR®" in Fallon in and multiply the values to calculate the total estimated cost savings, because informing the user of a backup

power supply of the cost savings realized through the use of such a device is an excellent means to justify the purchase and maintenance of a backup power supply and provide the user with additional data concerning the operation of their backup power supply.

As per claims 7 and 20, Fallon discloses a method and computer program product that estimates the cost savings attributable to use of a backup power system, the method comprising the following steps implemented on a data processing system: receiving historical power status information from a UPS over a communications link; (Figure 10; 0016; 0017; 0081; 0108; 0109) and displaying the estimate of cost savings on the user interface. (Figure 10; 0009; 0016; 0017).

Fallon fails to disclose accepting a power outage cost factor from a user interface and computing an estimate of cost savings based on the historical power status information and the power outage cost factor.

However, Eulau teaches the acceptance of a power outage cost factor from a user interface (Figure 13) and computing an estimate of cost savings based on the historical power status information and the power outage cost factor. (Figures 5-19; Col. 2, lines 5-50; Col. 3, line 65 - Col. 4, line 10; Col. 5, line 55 - Col. 6, line 15) Examiner interprets the data collected in Eulau to include both the cost per hour and single incident cost because the collection of data includes a wide range of values that can be used to accurately compute both of these values. Further, Examiner interprets the total revenue and profit at risk generated by Eulau to be the same as the potential amount

saved by a backup power supply. This is because a backup power supply abolishes power failures and reduces the risk to zero, thus recovering the total revenue and profit that was initially at risk.

Therefore, it would have been obvious to one of ordinary skill in the art to include the features of Eulau and "ENERGYSTAR®" in Fallon and multiply the values to calculate the total estimated cost savings, because informing the user of a backup power supply of the cost savings realized through the use of such a device is an excellent means to justify the purchase and maintenance of a backup power supply and provide the user with additional data concerning the operation of their backup power supply.

As per Claim 11, Fallon further discloses the calculator of claim 10 wherein the data processor is operatively associated with a graphical user interface (GUI) (Figure 10; 0009; 0016; 0017). Fallon fails to disclose wherein the GUI is configured to receive the historical power status information and transmit the historical power status information to the data processor.

However, Eualau teaches wherein the GUI is configured to receive the historical power status information and transmit the historical power status information to the data processor. (Figures 5-19; Col. 2, lines 5-50; Col. 3, line 65 - Col. 4, line 10; Col. 5, line 55 - Col. 6, line 15).

Therefore, it would have been obvious to one of ordinary skill in the art to combine the calculator and GUI disclosed in Fallon with features of "ENERGYSTAR®"

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and Eulau because informing the user of a backup power supply of the cost savings realized through the use of such a device is an excellent means to justify the purchase and maintenance of a backup power supply and provide the user with additional data concerning the operation of their backup power supply.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRED A. NELSON whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday and Wednesday-Friday, 8:30 AM -4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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/F. A. N./
Examiner, Art Unit 3628
5/27/2008

/JOHN W HAYES/
Supervisory Patent Examiner, Art Unit 3628